

### **Remarks**

The Final Office Action mailed on February 2, 2011 has been reviewed carefully and the application amended in a sincere effort to place the application in condition for allowance. Accordingly, reconsideration of the claims, and allowance of the same, are respectfully requested on the basis of the following remarks.

Upon entry of this Amendment, Claims 1-4, 9, 11, 18-19, 22-24, 26, 28, 30-31, and 35-42 will be pending in the application. Claims 5-8, 10, 12-17, 20-21, 25, 27, 29, 32-33, and 34 have been cancelled.

The Applicants have amended Claim 31 to address the 35 U.S.C. 112 issues that were raised by the Examiner in the Final Office Action. Because Claim 31 was the only amendment made to the claims and because the amendment was made solely to address the 35 U.S.C. 112 issues raised by the Examiner, the Applicants respectfully request entry of this amendment since it places the application in better condition for appeal.

### **Office Action Summary Sheet**

The Office Action Summary indicates that a certified copy of the priority document has not been received by the United States Patent and Trademark Office (hereinafter, the "Office"). However, upon review of the electronic file wrapper that is available on PAIR, it appears that the Office retrieved the document on September 9, 2010.

The Applicants, therefore, respectfully request that either: (i) the Office Action Summary Sheet be updated to show that the certified copy has been received by the Office; or (ii) the Office provide an explanation as to why the certified copy has not been received by the Office.

### **Rejection of Claim 31 under 35 U.S.C. 112**

The Examiner has rejected Claim 31 under 35 U.S.C. 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicants have amended Claim 31 to address the issues raised by the Examiner and, accordingly, submit that the rejection of this claim is now moot.

**Rejections of Claims 1-4, 9, 11, 18-19, 22-24, 26, 28, 30, 31, and 35-42 under 35 U.S.C. 103(a)**

The Examiner has rejected Claims 1-4, 9, 11, 18-19, 22-24, 26, 28, 30, 31, and 35-42 under 35 U.S.C. 103(a) for allegedly being unpatentable over U.S. Patent No. 6,403,665 (hereinafter, "Sieker") in view of U.S. Patent No. 5,143,945 (hereinafter, "Bodnar").

The Applicants appreciate the Examiner's direction given in the Final Office Action as to why the Applicants previous responses of August 20, 2010 and November 18, 2010 did not fully address the issue with regard to common ownership between Sieker and the present application.

The Applicants, therefore, submit that in addition to the evidence that was presented in the aforementioned responses, Sieker and the present application were, at the time this invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s) (see MPEP 706.02(I)(3)).

Because the Applicants have now made the required statement, the Applicants submit that Sieker can no longer be used as a reference under 35 U.S.C. 103(a) pursuant to 35 U.S.C. 103(c). Accordingly, the Applicants submit that the combination of Sieker and Bodnar is no longer proper.

**Rejections of Claims 1-4, 9, 11, 18-19, 22-24, 26, 28, 30, 31, and 35-36 under 35 U.S.C. 103(a)**

The Examiner has rejected Claims 1-4, 9, 11, 18-19, 22-24, 26, 28, 30, 31, and 35-36 under 35 U.S.C. 103(a) for allegedly being unpatentable over Bodnar.

As stated previously, in general, Bodnar appears to disclose a rigid polyurethane-polyisocyanurate foam prepared from (a) polyisocyanates, (b) polyols, (c) trimer catalyst, and (d) a blowing agent mixture wherein the mixture contains (i) a halocarbon, (ii) an organic carboxylic acid, and, optionally, (iii) water (see Abstract).

In other words, the presence of a halocarbon blowing agent is a required component. Moreover, as stated previously, Bodnar clearly states that the presence of the halocarbon blowing agent is the reason why his invention is novel and is, therefore, an essential and critical part of that invention (see Column 3, lines 38-56).

In contrast, the blowing agents recited in the Claims 1, 28, and 30 are selected from the group consisting of water, an alkane, an alkene, a cycloalkane, or combinations thereof, and when the blowing agent is selected from an alkane, an alkene, or a

cycloalkane, then the blowing agent consists of carbon and hydrogen atoms. In other words, none of the blowing agents recited in the present invention can be read to include the halocarbon blowing agent that is essential to Bodnar. For example, if the blowing agent of the present invention is selected from an alkane, alkene, or cycloalkane, then the blowing agent would only consist of carbon and hydrogen atoms. In other words, the blowing agent would not contain a halogen atom and would, therefore, not be consider a halocarbon.

Because Bodnar requires the use of a halocarbon blowing agent while the present invention specifically recites the use of blowing agents that cannot be considered a halocarbon, the Applicants submit that the Claims 1, 18, and 30, and the claims that depend therefrom, are in condition for allowance.

#### **Rejection of Claims 37-42**

The Examiner has rejected Claims 37-42 under 35 U.S.C. 103(a) for allegedly being unpatentable over Bondar in view of U.S. Patent No. 5,688,835 (hereinafter, "Scherbel").

The Examiner asserts that it would have been obvious to one skilled in the art to have replaced the halocarbons of Bodnar with the hydrocarbons disclosed in Scherbel. The Applicants, however, submit that one skilled in the art would not make such a modification in view of the teachings of Bodnar and that the Examiner, therefore, has not properly set forth a *prima facie* case of obviousness.

The Examiner explained in the Final Office Action that it would have been obvious for one having ordinary skill in the art to have replaced the halocarbons of Bodnar with the hydrocarbons of Scherbel for the purposes of imparting the foaming effect with environmentally advantageous results in order to arrive at the products and processes of Applicants' claims (see page 9 of the Final Office Action).

In light of the explicit teaching of Bodnar, however, the Applicants must respectfully submit the Examiner's line of reasoning is mere speculation. For example, Bodnar explicitly states that the **novelty** of his invention lies in the presence of the halocarbon blowing agent (see Column 3, lines 38-40). Additionally, Bodnar clearly states that total replacement of halocarbon blowing agents from the formulation disclosed therein will contribute to inferior physical properties of the end product (see Column 2, lines 8-30). Therefore, contrary to the Examiner's assertion, one skilled in the

art would not be motivated to replace the halocarbon blowing agents of Bodnar with the hydrocarbon blowing agents of Scherbel.

As the Examiner is well aware, rejections based on 35 U.S.C. 103(a) must rest on a factual basis, not speculation, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01. *KSR* (82 USPQ.2d at 1396) highlights the importance of determining "whether there was an apparent reason to combine the known elements in the fashion claimed by [Applicant]."

So, the point is not whether the skilled person **could** have arrived at the invention by modifying the prior art, but instead whether, in expectation of the advantages actually achieved, he or she would have done so because of promptings **in the prior art**.

Clearly, in this case, the combination of the cited references is improper due to the fact that Bodnar explicitly teaches away from the combination that the Examiner proposes.

Because the Examiner has not properly set forth a *prima facie* case of obviousness and because neither Bodnar nor Scherbel discloses every feature that is recited in Claims 37-42, the Applicants submit that these claims, and the claims that depend therefrom, are in condition for allowance.

### Conclusion

In light of the foregoing arguments as well as the Response filed on October 15, 2010, it is respectfully submitted that Claims 1-4, 9, 11, 18-19, 22-24, 26, 28, 30-31, and 35-42 are in proper form for issuance of a Notice of Allowance and such action is respectfully requested at an early date.

Respectfully Submitted,



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